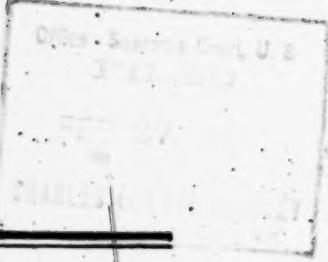


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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1941.

EXHIBIT SUPPLY COMPANY,

Petitioner,

No. 154.

vs.

ACE PATENTS CORPORATION,

Respondent.

GENCO., INC.,

Petitioner,

No. 155.

vs.

ACE PATENTS CORPORATION,

Respondent.

CHICAGO COIN MACHINE COMPANY,

Petitioner,

No. 156.

vs.

ACE PATENTS CORPORATION,

Respondent.

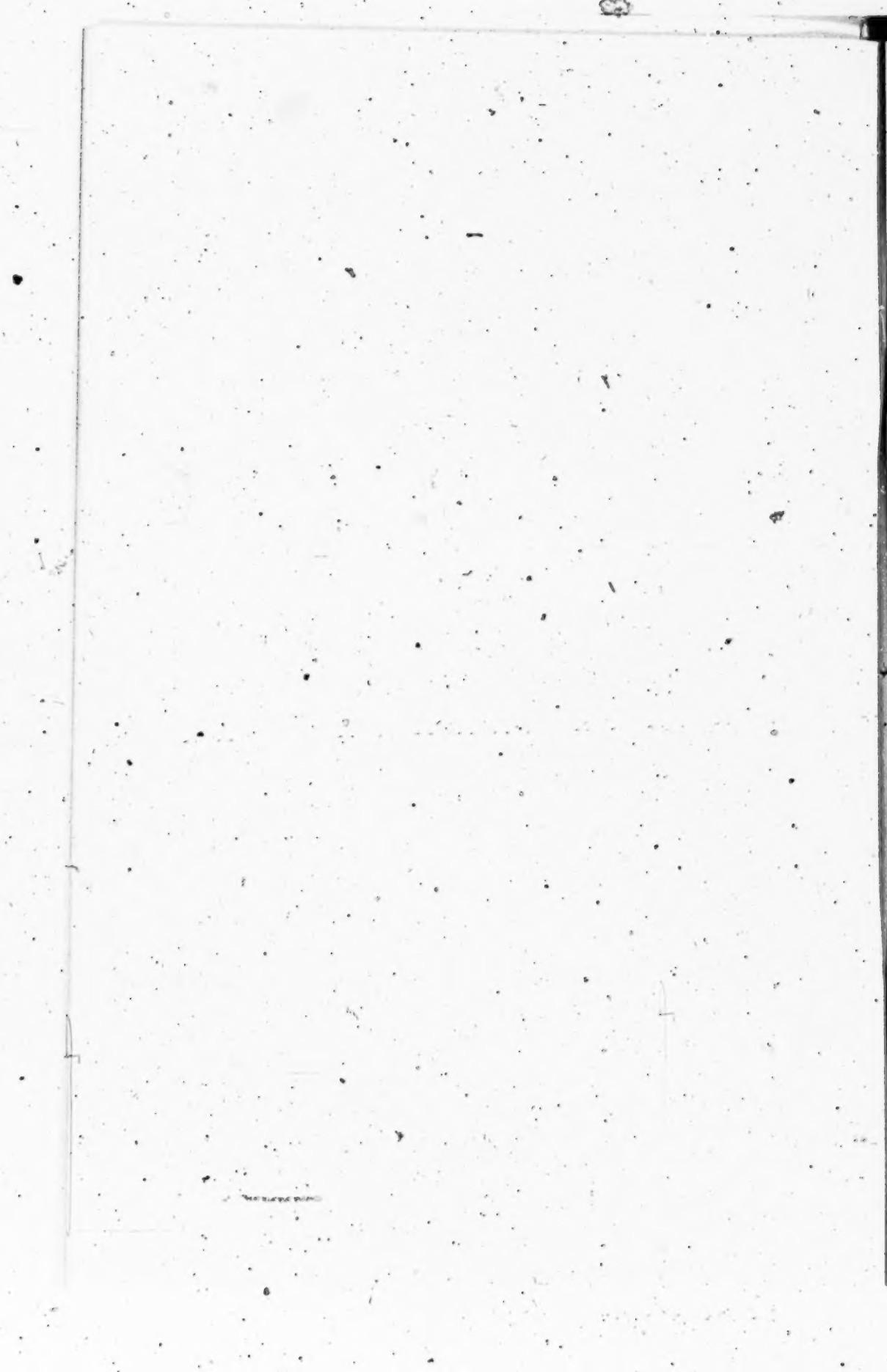
RESPONDENT'S PETITION FOR REHEARING.

CASPER W. OOMS,

Attorney for Respondent.

JOHN A. RUSSELL,

Of Counsel.



IN THE
Supreme Court of the United States

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EXHIBIT SUPPLY COMPANY, *Petitioner,*

No. 154. *vs.*

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CHICAGO COIN MACHINE COMPANY, *Petitioner,*

No. 156. *vs.*

ACE PATENTS CORPORATION, *Respondent.*

RESPONDENT'S PETITION FOR REHEARING.

To the Honorable the Chief Justice of the United States
and the Associate Justices of the Supreme Court of the
United States:

This Court, in its opinion of February 2, 1942, in these cases, held that claim 4 of the Nelson patent in suit, because of an amendment made during the prosecution of the patent claim, was limited to devices in which the complementary conductor means was "embedded in the table". The Court

then held that the devices exemplified in Plaintiff's Exhibits 5 and 7 infringed the claim and the other four accused devices did not. . .

This conclusion was apparently based upon the misapprehension expressed by the Court that, "Respondent concedes that the conductor means in the four devices are not literally 'embedded in the table'" (Opinion, p. 8.) Respondent did make this concession with respect to two of the devices held not to infringe, i. e., Plaintiff's Exhibits 8 and 9.

Respondent has not conceded and does not concede that the two devices (Pl. Exh. 6 and 10) in which the pin is "embedded in the table" by being embedded in a plate overlying the board portion of the table, is not "embedded in the table".

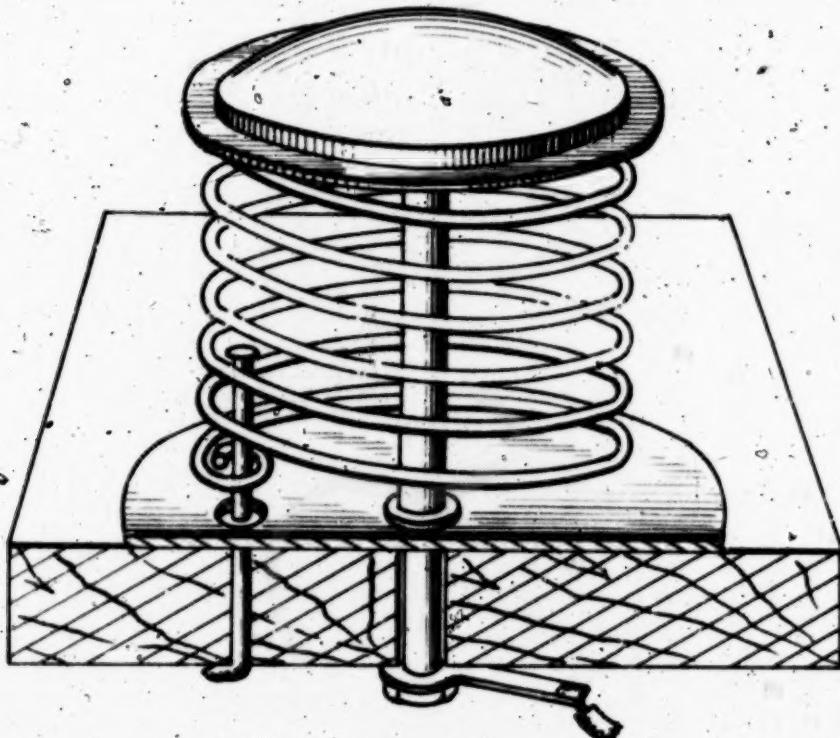
The Court's reading of the claim reads an additional limitation into the phrase in dispute, as if it read, "embedded in the *wooden or board portion of the table*". The claim is not so written. The metal plate overlying the board portion of the table is a part of the table. A pin embedded in that part of the table is "embedded in the table".

* This is evident in the accompanying comparative sketch of the devices exemplified in Plaintiff's Exhibits 5 and 6. In both devices the pin is "embedded in the table". In the first (Pl. Exh. 5) it is directly embedded in the board portion. In the second form (Pl. Exh. 6) the pin is embedded in the metal plate which forms a lamination of the table, but is nevertheless as clearly "embedded in the table". This is obvious.

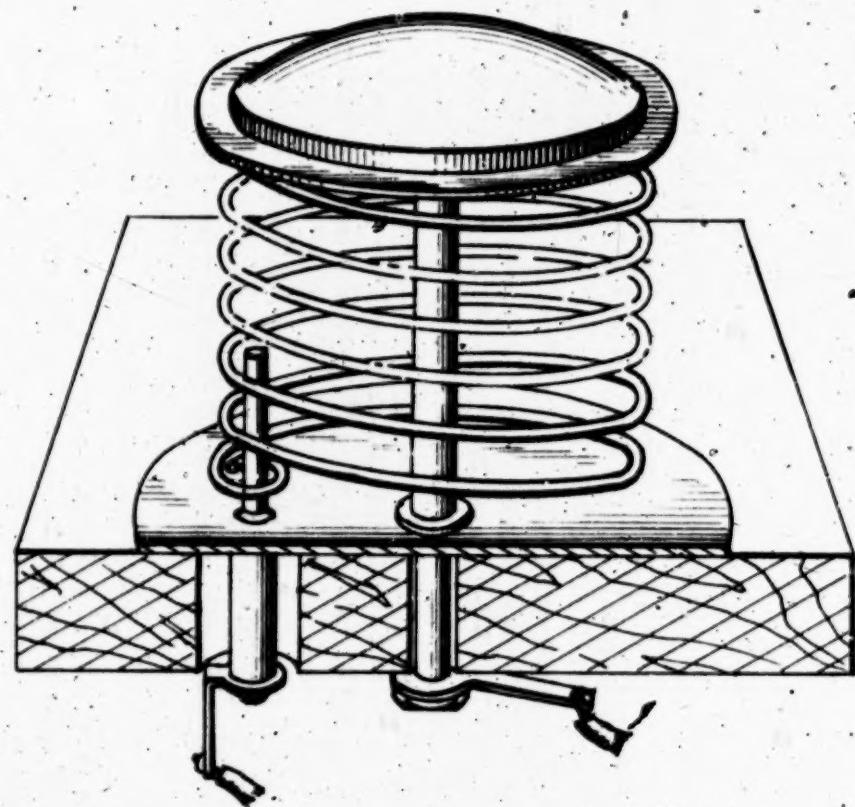
This contention of Respondent is not new. It was made throughout the case, and in the briefs before this Court, where it was clearly stated that any question of equivalents in the case related only to Plaintiff's Exhibits 8 and 9.



PLAINTIFF'S EXHIBIT 5
(HELD TO INFRINGE)



PLAINTIFF'S EXHIBIT 6



**COMPARATIVE CHART OF PLAINTIFF'S
EXHIBITS 5 & 6**



In the Brief for Respondent here, on pages i and ii of the Table of Contents, Respondent said:

"Plaintiff's Exhibits 6 and 10 Differ from Plaintiff's Exhibits 5 and 7 Only in the Fact That Petitioners Have Cut a Large Hole in the Pin Table at the Point Where the Conductor Is Normally Embedded, and Have Covered This Hole With an Additional Lamination of Material Which Is Secured to the Pin Table by the Standard, and Have Embedded the Conductors in This Top Lamination.

"Plate IV. By Adding a Passive Plate to the Board in Plaintiff's Exhibits 6 and 10 Defendants Have Merely Constructed a Laminated Board in an Astute Effort to Evade the Literal Terms of the Claim Without Impairing the Structure or Function of the Nelson Invention."

On page 4 of that Brief Respondent said:

"The contention of non-infringement in this case is based upon the fact that in two of the infringing devices, Pl. Exh. 5 and 7, Petitioners have substituted for the ferrule mounted in the pin table board a nail or pin which is embedded in the board, and have formed a ring or ferrule at the end of the resilient coil spring to surround the pin. This is a simple reversal. Response to the claim is evident. (See Plate III at page 14 herein.)

"As to the next class of infringing devices, typified by Pl. Exh. 6 and 10, Petitioners have made the additional alteration that instead of embedding the pin directly in the pin table board, they have added to the board another lamination, which is rigidly anchored and attached to the board by means of the coil spring standard, and have embedded the pin in this upper lamination of the pin table board. This involved merely the addition of a completely passive element which became a part of the board. The attempted evasion is purely a literary device and a most transparent effort to retain all of the structural and functional characteristics of Nelson with a verbal distinction to fall back upon in case of attack. (See Plate IV at page 22 herein.)

"In the last two devices to be considered, Pl. Exh. 8 and 9, the upper lamination of the pin-table board has been removed and substituted therefor is an insulating core, which spaces the conductor from the resilient coil standard, and is anchored to the standard, which is embedded in the board, so that functionally the conductor member itself is embedded in the board. (See Plate V at page 24 herein.)

"These three classes of infringing devices will be discussed in turn, and the question of file wrapper estoppel, upon which Petitioners based their prayer for the writs granted herein, will be treated in connection with the last two devices, the only devices to which any consideration of that question is pertinent."

On pages 21 and 22 Respondent said:

"As is readily apparent from an examination of the accompanying Plate IV, the second class of infringing devices also employs a pin embedded in the board and an annular termination of the coil spring surrounding the pin to form the switch. Unlike the devices previously discussed, Pl. Exh. 5 and 7, the two devices here shown include the additional modification that the pin is embedded in a plate, which is in turn secured to the board in such a manner that it forms merely an upper lamination of the board. The metal plate serves no function whatsoever except to support the pin where, in the previous devices it was driven directly into the board.

"Can it be seriously contended that this simple device by which the pin table is transformed from a single solid board into a structure composed of a solid board with an overlying metal lamination, avoids the terms of Nelson claim 4? The question answers itself.

"The courts have uniformly, when called upon to consider the question of the separation of one unit or element of a structure into two parts which perform the same function in identically the same manner, held that infringement is not avoided by so obvious and transparent a subterfuge."

"That this rearrangement of the parts of Petition-

ers' bumper spring to embed the conductor in the added lamination of the table, instead of embedding the conductor directly in the table, does not avoid infringement is the necessary effect of the many decisions of this court dealing with the question of mechanical equivalents."

Upon these considerations it is respectfully submitted that the Court has erred in excluding the two devices exemplified by Plaintiff's Exhibits 6 and 10 from the judgment of infringement. Wherefore it is respectfully prayed that Respondent be reheard upon this issue and that the judgment of the Court be accordingly corrected.

Respectfully submitted,

CASPER W. OOMS,

Attorney for Respondent.

JOHN A. RUSSELL,

Of Counsel.

February 24, 1942.

I hereby certify that the foregoing Petition for Rehearing is filed in good faith and not for the purpose of delay.

CASPER W. OOMS,

Attorney for Respondent.



SUPREME COURT OF THE UNITED STATES.

Nos. 154, 155, 156.—OCTOBER TERM, 1941.

Exhibit Supply Company, Petitioner,

154

vs.

Ace Patents Corporation.

Genco, Inc., Petitioner,

155

vs.

Ace Patents Corporation.

Chicago Coin Machine Company,

Petitioner,

156

vs.

Ace Patents Corporation.

On Writs of Certiorari to
the United States Circuit Court of Appeals
for the Seventh Circuit.

[February 2, 1942.]

Mr. Chief Justice STONE delivered the opinion of the Court.

Respondent began the present litigation as three separate suits against the respective petitioners for infringement of the Nelson Patent No. 2,109,678 of March 1, 1938, for a "contact switch for ball rolling games." The defenses were non-invention in view of the prior art, anticipation by prior publication, use and sale, non-infringement and a file wrapper estoppel. The three suits were consolidated and tried together. Upon full consideration of the issues the District Court and the Circuit Court of Appeals for the Seventh Circuit held Claim 4 of the patent valid and infringed. 119 F. 2d 349.

We granted certiorari, 314 U. S. —, on a petition which challenged only the decree of infringement below, on the ground that it enlarged the scope of the patent as defined by the claim, by resort to the doctrine of equivalents, and that Nelson, the patentee, by the amendment of his claims in the Patent Office, had surrendered Claim 4 so far as it would otherwise read upon the alleged infringing devices. Neither in their petition nor in their brief and argument in this Court have petitioners contended that the patent is invalid for want of invention. Although there is no conflict of decision, we were moved to grant the petition by

the nature of the questions presented, together with a showing that the industry affected by the patent is located in the seventh circuit so that litigation in other circuits resulting in a conflict of decision would not be likely to occur.

The patent relates to the structure of a resilient switch or circuit closer, so disposed on the board of a game table as to serve as a target which, when struck by a freely rolling ball, will momentarily close an electrical circuit. Specifications and drawings disclose a target or switch comprising a conductor standard mounted in the table and carrying a coil spring having a leg pendantsly disposed in a conductor ring located in the table and slightly offset from the standard. The standard and ring are wired in a circuit with a relay coil and a source of electrical energy. When a ball rolling on the table bumps the coil spring from any direction, the leg of the spring is deflected momentarily bringing it into contact with the ring, so as to close the circuit for operating the relay coil and any connected auxiliary game device. Any desired number of targets may be placed on the board in a suitably spaced relationship; in pin ball games a single ball may successively bump and close a number of the switch devices. In describing his invention the patentee declared it to be his intention "to cover all changes and modifications of the example of the invention herein chosen for purposes of the disclosure, which do not constitute departures from the spirit and scope of the invention."

The prior art as disclosed by the record shows no device in which the coil spring serves both as a target and a switch. The advantages of the device are said to be that the combination is peculiarly adapted to use in pin ball games; that the coil spring structure is so organized as to form both a switch for operating auxiliary recording or signalling devices and a target which is accessible from any direction.

Claim 4¹ claims as the elements of the invention the conductor standard anchored in the table, the coil spring surrounding the standard which carries the spring pendantsly from its top, with the

¹ 4. In a ball rolling game having a substantially horizontal table over which balls are rollable, the combination with said table of a substantially vertical standard anchored in said table with its lower end carrying on the underside of the table a lead for an electric circuit and its upper end extending a substantial distance above the top surface of the table, a coil spring surrounding the standard, means carrying said spring pendantsly from the

spring spaced from the standard to enable the spring to be resiliently flexed, "and conductor means in said circuit and embedded in the table at a point spaced from the standard and engageable by a portion of the spring when it is flexed to close the aforementioned circuit." The drawings of the patent show the "conductor means" last mentioned in the form of a ring or ferrule set in the table with its axis at right angles to the table and with its flange projecting slightly above the surface of the table. The leg pending from the coil spring is so disposed at the center of the annular ferrule that a ball striking the spring in any direction will bring the pendant leg into contact with the ring so as to close the circuit.

The six devices alleged to infringe the patent differ from the particular claim of the invention described in the specifications, only in the specific form and method of supporting the "conductor means" which is "engageable by a portion of the spring when it is flexed". In two of the accused devices, plaintiff's Exhibits 5 and 7, there is substituted for the ring conductor set in the table a nail or pin driven into the table and surrounded near its upper end by a ring attached to the end of the resilient coil spring, or formed there of the coil wire. When the spring is struck the circuit is closed by the contact of ring and nail at a point above the table. This arrangement contrasts with that of the conductors as shown in the patent drawings, in which a ring set in the table and the pendant leg of the coil form the contact at a point near or below the surface of the table. In the one case the ring conductor is supported by the table and the complementary conductor is attached to or is formed of the wire of the spring at its end. In the other the locations of the ring and of the complementary conductor are reversed.

Two others of the accused devices, plaintiff's Exhibits 6 and 10, show a further alteration. In Exhibit 6, the nail or pin, instead of being driven directly into the table, is affixed to and supported by a metal plate resting on the upper surface of the table with the coil spring standard passing through it and holding it firmly on

upper portion of the standard above the table with the coils of the spring spaced from the standard to enable the spring to be resiliently flexed when bumped by a ball rolling on the table, said spring being in the aforementioned circuit and constituting a conductor, and conductor means in said circuit and embedded in the table at a point spaced from the standard and engageable by a portion of the spring when it is flexed to close the aforementioned circuit."

4 *Exhibit Supply Company vs. Ace Patents Corp.*

the table. The conductor extends to the wire connection through a hole in the table underneath the plate. In Exhibit 10 the conductor is insulated from the plate, which is rigidly anchored to the coil spring standard, which in turn is anchored to the table.

In the remaining two accused devices, plaintiff's Exhibits 8 and 9, an insulating core or sleeve surrounds the coil standard and supports an annular or enveloping conductor wired in the circuit, spaced and insulated from the coil standard so that the circuit is closed by contact of the conductor and the coil when it is flexed. In Exhibit 8 the sleeve is electrically connected with a metal plate, held in position on the top of the table by the standard which passes through the plate. A wire leading from the plate passes through a hole in the table underneath the plate. In Exhibit 9 the annular conductor is located above the table top and a wire leading from it passes through a hole in the table.

Comparison of the several accused devices shows that in all but Exhibits 5 and 7 the conductor means complementary to the coil spring is not embedded in the table, but is supported by an insulated plate resting on the table or an insulating core held in position by the standard. In Exhibits 6 and 10 the conductor means passes to its wire connection through a hole in the table underneath the plate. In Exhibit 8 the connecting wire passes through a hole in the table to a metal plate resting on its surface, and in Exhibit 9 to the conductor means located above the surface of the table.

Petitioners insist that respondent is estopped to assert infringement by the file wrapper record in the Patent Office and in any event that estoppel can be avoided and infringement established only by resort to the doctrine of equivalents, which they assert is incompatible with the statutory requirements for the grant of a patent and with the doctrine that the patent claims measure the patented invention.

The file wrapper history, so far as now relevant, relates to Claim 7 which, after amendment, was allowed as Claim 4 now in

issue. The original Claim 7 with its amendments is set forth as follows:

[Matter added by amendment in parentheses; matter stricken in italics and underscored.]

(4) 7. In a ball rolling game having a substantially horizontal table over which balls are rollable,

the combination with said table of a substantially vertical standard anchored in said table with its lower

end carrying on the underside of the table a lead for an

A¹ electric circuit and its upper end extending a substantial distance above the top surface of the table, a

coil spring surrounding the standard, means carrying

said spring pendently from the upper portion of the

per C standard (ABOVE THE TABLE) with the coils of the spring spaced from the

" " standard and the lower end of the coil spring terminating

" " at a distance above the top surface of the table to enable the spring to be resiliently flexed when bumped

by a ball rolling on the table, said spring being in the

forementioned circuit and constituting a conductor, and

per B other conductor means (IN SAID CIRCUIT AND EMBEDDED IN) carried by the table at a point

spaced from the standard and engageable by a portion of

the spring when it is flexed to close the aforementioned circuit.

The original application contained six claims, all of which the examiner rejected because he thought no patentable significance had been shown. The inventor submitted certain amendments, and two new claims, 7 and 8, and induced the examiner to reconsider the patentability of the invention. Four of the claims were then allowed, but the examiner rejected Claim 7 as failing to claim the invention. He said: "It is old in the art to make an electrical contact by flexing a coil spring as shown by the art already cited in the case. In order to distinguish over the references therefor, the applicant's particular type of contact structure, comprising an extension to the coil spring adapted to engage an annular contact embedded in the table, must appear in the claims."

Applicant rejected the examiner's suggestion that the "contact structure" be adapted to engage "an annular contact embedded in the table". Instead he cancelled "other" from the claim and substituted for "carried by" the phrase, "in said circuit and embedded in", saying Claim 7 has been "significantly amended" "to define the complementary conductor contact as being embedded in the table". He added that "it is too far to go to state that the specific leg 19 must be defined", and "the allowed claims can it seems, be very simply avoided by taking the leg 19, separating it from the spring 18 and embedding it as a pin in the table so that the spring when flexed would contact the pin. . . . Claim 7 covers such alternative form and . . . in justice to applicant should be allowed."

The examiner in reply recognized as "true" applicant's suggestion that if the leg pendant from the spring "were removed from the spring and embedded in the table an operative device would result", but pointed out that the device claimed by the amendment "would be inoperative as the coil spring could not both terminate at a distance above the table and extend into a ferrule embedded therein." Thereupon the applicant added to the claim the words "above the table" and cancelled the phrase, "and the lower end of the coil spring terminating at a distance above the top surface of the table." The claim as amended was then allowed as Claim 4.

The claim before amendment plainly read on plaintiff's Exhibits 5 and 7 in which the nail or pin conductor is driven into the table, since the nail or pin is a "conductor means carried by the table" "engageable by a portion of the spring when flexed".

The claim thus read is for an operative device since the nail or pin projects above the table and may be engaged by the coil spring similarly located. The claim, as amended and allowed as Claim 4, likewise reads on plaintiff's Exhibits 5 and 7 if the nail or pin conductor which is driven into the table is "embedded in the table".

Petitioners do not seriously assert here that it is not so embedded. In fact their brief expressly states that "we pass this contention". They could not well do otherwise, for the pin or nail even though it protrudes above or below the table not only conforms to the dictionary definition of "embed", "To set solidly as in a bed", Webster; "To fix firmly in a surrounding mass of some solid material", Oxford Dictionary, but examination of the drawings and specifications indicates clearly enough that the claim was not intended to be limited to a complementary conductor located wholly between the upper and nether surfaces of the table. The specifications and drawings express no such limitation, and it is clear that the use of the word "embedded" in the claim as finally amended, when read in its context of claim and specifications, does not indicate such a limitation.

The patent drawings show the embedded ring conductor extending slightly both above and below the table. The examiner in his second rejection of Claim 7, in saying that if the leg pendant from the spring were removed from the spring and "embedded" in the table an operative device would result, could not have referred to the embedded leg or nail as being wholly located below the surface of the table, since the pin so disposed would not be "engageable" "by a portion of the spring when it is flexed" by a ball rolling in any direction. The term is to be read as used in a permissible sense which would conform to the drawings and the function which the conductor to which the term was applied was obviously intended to perform.

We think that the word "embedded" as applied in Claim 4, must be taken to embrace any conductor means solidly set or firmly fixed in the table, whether or not it protrudes above or below the surface. Claim 7 before amendment read on the accused devices, plaintiff's Exhibits 5 and 7, which exhibit the nail or pin embedded in the table but protruding above its surface. Consequently the patentee by amending the claim so as to define the conductor means as embedded in the table did not exclude from the

amended claim devices exemplified by these exhibits and they must be deemed to be infringements.

There remains the question whether respondent may rely upon the doctrine of equivalents to establish infringement by the four other accused devices. Respondent concedes that the conductor means in the four devices are not literally "embedded in the table", but insists that the changes in structure which they exhibit over that of plaintiff's Exhibits 5 and 7 are but the mechanical equivalents of the "conductor means embedded in the table" called for by the amended claim, and so are entitled to the protection afforded by the doctrine of equivalents. Petitioners do not seriously urge that the conductor means in the four accused devices are not mechanical equivalents of the conductor means embedded in the table which the patent claims. Instead they argue that the doctrine should be discarded because it does not satisfy the demands of the statute that the patent shall describe the invention. R. S. § 4888; 35 U. S. C. § 33.

We do not find it necessary to resolve these contentions here. Whatever may be the appropriate scope and application of the doctrine of equivalents, where a claim is allowed without a restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment.

Assuming that the patentee would have been entitled to equivalents embracing the accused devices had he originally claimed a "conductor means embedded in the table", a very different issue is presented when the applicant in order to meet objections in the Patent Office, based on references to the prior art, adopted the phrase as a substitute for the broader one "carried by the table". Had Claim 7 been allowed in its original form it would have read upon all the accused devices since in all the conductor means complementary to the coil spring are "carried by the table". By striking that phrase from the claim and substituting for it "embedded in the table" the applicant restricted his claim to those combinations in which the conductor means, though carried on the table, is also embedded in it. By the amendment he recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference. *Hubbell v. United States*, 179 U. S. 77, 83; *Weber Electric Co. v. Freeman Electric Co.*, 256 U. S. 668, 677-78; *I. T. S. Rubber Co. v. Essex Rubber Co.*,

272 U. S. 429, 440, 444; *Smith v. Magic City Kennel Club*, 282 U. S. 784, 789; *Schriber Co. v. Cleveland Trust Co.*, 311 U. S. 211; cf. in case of disclaimer *Altoona Theatres v. Tri-Ergon Corp.*, 294 U. S. 477, 492, 493. The difference which he thus disclaimed must be regarded as material, and since the amendment operates as a disclaimer of that difference it must be strictly construed against him. *Smith v. Magic City Kennel Club, supra*, 720; *Shepard v. Carrigan*, 116 U. S. 593, 598; *Goodyear Dental Vulcanite Co. v. Davis*, 102 U. S. 222, 228. As the question is one of construction of the claim it is immaterial whether the examiner was right or wrong in rejecting the claim as filed. *Hubbell v. United States, supra*, 83; *I. T. S. Rubber Co. v. Essex Rubber Co., supra*, 443. It follows that what the patentee, by a strict construction of the claim, has disclaimed—conductors which are carried by the table but not embedded in it—cannot now be regained by recourse to the doctrine of equivalents, which at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed.

Plaintiff's Exhibits 5 and 7 do, and its Exhibits 6, 8, 9 and 10 do not, infringe. The judgments will be modified accordingly.

So ordered.

Mr. Justice ROBERTS took no part in the consideration or decision of this case.

A true copy.

Test:

Clerk, Supreme Court, U. S.



SUPREME COURT OF THE UNITED STATES.

Nos. 154, 155, 156.—OCTOBER TERM, 1941.

Exhibit Supply Company, Petitioner,
154 vs.

Ace Patents Corporation.

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Chicago Coin Machine Company,
Petitioner,
156 vs.

Ace Patents Corporation.

On Writs of Certiorari to
the United States Cir-
cuit Court of Appeals
for the Seventh Circuit.

[February 2, 1942.]

Mr. Justice BLACK, dissenting, with whom Mr. Justice DOUGLAS concurs.

I think the judgments below should be reversed in full.

There can be no infringement of a void patent, and a patent which shows neither invention nor discovery is void.¹ The mere application of an old mechanical instrument to a new use is not an invention and therefore not patentable.²

The combination patented here contains not a single new element. The whole device is nothing more than an electric switch mounted on a table, which closes and opens with the flexing and reflexing of an ordinary coil spring when hit by a rolling ball. The spring, standing upright on the table, serves as a target in a pin ball game, its resiliency being utilized not only to make and break the circuit but to make the ball rebound.

The Constitution authorizes the granting of patent privileges only to inventors who make "discoveries." And the statute provides for the granting of patents only to those who have "invented

¹ *Dunbar v. Myers*, 94 U. S. 187; *Thompson v. Boisselier*, 114 U. S. 1; *Saranac Mach. Co. v. Wirebound Co.*, 282 U. S. 704.

² *Phillips v. Page*, 24 How. 164; *Paramount Corp. v. Tri-Ergon Corp.*, 294 U. S. 464.

or discovered" something "new." To call the device here an invention or discovery such as was contemplated by the Constitution or the statute is, in my judgment, to degrade the meaning of those terms.

Patentees have rights given them by law. "But the public has rights also. The rights of both should be upheld and enforced by an equally firm hand, whenever they come under judicial consideration."³ By failing to assign error on the issue of patentability, parties to an infringement suit should not be permitted to foreclose a court from protecting the public interest. And here, as in other cases where there is plain error, we should notice it.⁴

³ *Densmore v. Scofield*, 102 U. S. 375, 378.

⁴ *Sibbach v. Wilson & Co.*, 312 U. S. 1, 16.

EJ

